

REMARKS

Claims 2, 30, 32, 60, 62 and 90 have been canceled by a prior amendment without prejudice or disclaimer of the subject matter thereof.

Claims 27, 57 and 87 have been canceled by the subject amendment without prejudice or disclaimer of the subject matter thereof. Applicants reserve the right to pursue the subject matter of any of the canceled claims in subsequently filed continuing applications.

Claims 1, 22, 31, 61 and 82 have been amended.

Claims 1, 3 - 26, 28 - 29, 31, 33 - 56, 58 - 59, 61, 63 - 86, 88 - 89 and 91 - 99 are present and pending in the subject application.

In the Office Action dated July 18, 2007, the Examiner has rejected claims 1, 31 and 61 under 35 U.S.C. §112, second paragraph, and has rejected claims 1, 3 - 29, 31, 33 - 59, 61, 63 - 89 and 91 - 99 under 35 U.S.C. §103(a). Favorable reconsideration of the subject application is respectfully requested in view of the following remarks.

The Examiner has rejected claims 1, 31 and 61 under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner takes the position that the terms “said selected object”, “each selected object” and “said specified location” recited in claims 1, 31 and 61 are unclear as to the items being referenced.

This rejection is respectfully traversed. Claims 1, 31 and 61 each recite the features of enabling selection by a user of one or more selectable objects. Thus, the claims clearly recite

that a user selects one or more of the objects. The terms “said selected object” and “each selected object” refer to the objects selected by the user as recited in the claims.

Claims 1, 31 and 61 each further recite the feature of enabling specification by the user of a location for the selected objects within the hierarchical structure. Thus, the claims clearly recite that the user further specifies a location for the objects the user selected. The term “said specified location” refers to the location specified by the user for the objects as recited in the claims.

Since the claim terms identified by the Examiner clearly refer to features recited within the claims, the claims are considered to be definite and comply with 35 U.S.C. §112, second paragraph.

The Examiner has rejected claims 1, 6 - 8, 11 - 23, 25 - 28, 31, 36 - 38, 41 - 53, 55 - 58, 61, 66 - 68, 71 - 83, 85 - 88, 91, 94 and 97 under 35 U.S.C. §103(a) as being unpatentable over The McGraw-Hill companies publication in view of U.S. Patent No. 6,886,036 (Santamaki et al.). This rejection is moot with respect to canceled claims 27, 57 and 87.

Briefly, the present invention is directed toward a system, method and data storage device for creating and storing a content object in a data repository as a group of hierarchically related content entities. Each content entity is contained in a separate file object. A list or outline containing container and non-container identifiers defines the content, order and structure of the content object. This list or outline is stored as a separate file object.

The Examiner takes the position with respect to independent claims 1, 31 and 61 that the McGraw-Hill publication discloses all the features within these claims, except for a library server

for storing the information and attribute of the e-book. The Examiner further alleges that the Santamaki et al. patent discloses these features, and that it would have been obvious to combine the teachings of the McGraw-Hill publication and Santamaki et al. patent to attain the claimed invention.

This rejection is respectfully traversed. However, in order to expedite prosecution of the subject application, independent claims 1, 31 and 61 have been amended and recite the features of: enabling entry of a title by the user for the specified location within the hierarchical structure for a corresponding selected object and assigning the entered title to that specified location, wherein the entered and assigned title is different than the included title of the corresponding selected object to provide the corresponding selected object with a title within the content object different than the included title. Dependent claims 22 and 82 have been amended to correct a minor typographical error and/or for consistency with their amended parent claims.

The McGraw-Hill publication does not disclose, teach or suggest these features. Rather, the McGraw-Hill publication discloses a database containing a collection of modular, stand-alone text files that can be mixed, matched and arranged to create a new book for a particular course. A user may select various portions of existing books to add to the new book being created. The existing books are displayed in a table of contents type format and enable selection of portions for viewing and/or addition to the new book (e.g., as viewed in Slide 1 cited by the Examiner). A user may view the contents of the new book, where the new book contents are displayed with each selected portion indicated in the new book by their title from the book and/or chapter from which they were selected (e.g., as viewed in Slide 2 cited by the Examiner). For

example, the portion entitled “The Mischiefs of Faction, James Madison” is illustrated in Slide 1 that provides items from the book “We the People, Third Edition” for selection by the user for the new book. Slide 2 illustrates the new book with portions selected by the user. The portion entitled “The Mischiefs of Faction, James Madison” was apparently selected and is shown in Slide 2 with the title “The Mischiefs of Faction, James Madison” at a particular location within the new book.

Thus, the McGraw-Hill publication discloses that the selected portions in the new book (Slide 2) include the title from the book or chapter from which the portions were selected (Slide 1). There is no disclosure, teaching or suggestion of: enabling entry of a title by the user for the specified location within the hierarchical structure for a corresponding selected object and assigning the entered title to that specified location, wherein the entered and assigned title is different than the included title of the corresponding selected object to provide the corresponding selected object with a title within the content object different than the included title. In other words, the McGraw-Hill publication does not disclose, teach or suggest enabling a user to specify a title for a selected portion in the new book different than the title of that selected portion within the book or chapter from which that portion was selected as recited in the claims.

The Santamaki et al. patent does not compensate for the deficiencies of the McGraw-Hill publication. Rather, the Santamaki et al. patent is directed toward an electronic book system for advancing distribution of reading materials and is merely utilized by the Examiner for an alleged teaching of centralized and e-book servers allegedly corresponding to the claimed library server.

Since the McGraw-Hill publication and Santamaki et al. patent do not disclose, teach or suggest, either alone or in combination, the features recited in independent claims 1, 31 and 61 as discussed above, these claims are considered to be in condition for allowance.

Claims 6 - 8, 11 - 23, 25 - 26, 28, 36 - 38, 41 - 53, 55 - 56, 58, 66 - 68, 71 - 83, 85 - 86, 88, 91, 94 and 97 depend, either directly or indirectly, from independent claims 1, 31 or 61 and, therefore, include all the limitations of their parent claims. These claims are considered to be in condition for allowance for substantially the same reasons discussed above in relation to their parent claims and for further limitations recited in the claims.

The Examiner has rejected claims 3, 29, 33, 59, 63 and 89 under 35 U.S.C. §103(a) as being unpatentable over the combination of the McGraw-Hill publication and Santamaki et al. patent, and further in view of U.S. Patent No. 6,091,930 (Mortimer et al.). Further, the Examiner has rejected claims 4 - 5, 34 - 35 and 64 - 65 under 35 U.S.C. §103(a) as being unpatentable over the combination of the McGraw-Hill publication and Santamaki et al. patent, and further in view of ksinclair.com. In addition, the Examiner has rejected claims 9 - 10, 24, 39 - 40, 54, 69 - 70, 84, 92 - 93, 95 - 96 and 98 - 99 under 35 U.S.C. §103(a) as being unpatentable over the combination of the McGraw-Hill publication and Santamaki et al. patent, and further in view of U.S. Patent No. 6,006,242 (Poole et al.).

These rejections are respectfully traversed. Initially, each of the pending claims within these rejections depends from claims 1, 31 or 61 and, therefore, includes all the limitations of their parent claims. As discussed above, the combination of the McGraw-Hill publication and Santamaki et al. patent does not disclose, teach or suggest the features recited in the independent

claims of enabling entry of a title by the user for the specified location within the hierarchical structure for a corresponding selected object and assigning the entered title to that specified location, wherein the entered and assigned title is different than the included title of the corresponding selected object to provide the corresponding selected object with a title within the content object different than the included title.

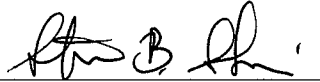
The art cited in these rejections does not compensate for the deficiencies of the combination of the McGraw-Hill publication and Santamaki et al. patent. Rather, the Mortimer et al. patent is directed toward a customizable interactive educational system and is merely utilized by the Examiner for an alleged teaching of a collection of content comprising an image album and a video. The ksinclair.com publication is directed toward a web site offering free downloading of e-books and is merely utilized by the Examiner for an alleged teaching of calculating a cost of an object. The Poole et al. patent is directed toward an apparatus for dynamically constructing electronic and printable documents and forms and is merely utilized by the Examiner for alleged teachings of: defining a maximum amount of allowable content per volume of content; creating a plurality of volumes of content from the selected content based on the defined maximum; selectively moving an object between volumes; including associated prerequisite subsets; recording in a computer readable structure a reference to corresponding content entities; and defining the compilation in a custom content outline. Accordingly, the above pending claims are similarly considered to be in condition for allowance.

AMENDMENT
U.S. Appl. No. 09/489,134

Attorney Docket No. (0920.0034C)
STL000012US1

The application, having been shown to overcome issues raised in the Office Action, is considered to be in condition for allowance and Notice of Allowance is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Stuart B. Shapiro', is written over a horizontal line.

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